



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
06/627,980	07/05/84	MIYASAKA	T 55153P

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EXAMINER	
GIBSON, S	
ART UNIT	PAPER NUMBER
122	4

DATE MAILED: 05/31/85

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined       Responsive to communication filed on \_\_\_\_\_       This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.

Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |  |  |
|--|--|
| <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | <input type="checkbox"/> Notice re Patent Drawing, PTO-848.                  |
| <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449                  | <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474      | <input type="checkbox"/> _____   |

Part II SUMMARY OF ACTION

1.  Claims 1-22 are pending in the application.

Of the above, claims 18-22 are withdrawn from consideration.

2.  Claims \_\_\_\_\_ have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 1-17 are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.

8.  Allowable subject matter having been indicated, formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. These drawings are  acceptable;  not acceptable (see explanation).

10.  The  proposed drawing correction and/or the  proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been  approved by the examiner.  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed \_\_\_\_\_, has been  approved.  disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.

12.  Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has  been received  not been received

been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

Art Unit 122

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-17, drawn to compounds, classified in Classes 544; 546, subclasses 60, 125, 361; 48. If elected applicants must elect a single disclosed species, as required under 35 USC 121.

II. Claims 18-22, drawn to processes of preparing the instantly claimed compounds, classified in Classes 544; 546, subclasses 60, 125, 361; 48.

The inventions are separate and distinct, each from the other because of the following reasons:

Inventions group II and group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as one of the two separate and distinct processes instantly claimed or by one of the processes taught by Miyasaka et al '695.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter restriction for examination purposes as indicated is proper.

Art Unit 122

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

During a telephone conversation with Mr. Stewart on April 25, 1985 a provisional election was made with traverse to prosecute the invention of group I, example 5 the elected specie, claims 1-17. Affirmation of this election must be made by applicant in responding to this Office action.

Claims 18-22 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention.

Claims 1, 2, 6-8, 12, 13, 15, 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

The following reasons apply:

6(c)1. The specification is enabling for a portion of the subject matter claimed but the specification is not commensurate in scope with the claims where R<sup>2</sup>/R<sup>3</sup> or NR<sup>8</sup>R<sup>9</sup> are a "heterocyclic group.... interrupted with O, S and/or N". Do applicants also intend thiazole, oxazole,

Art Unit 122

quinoline, pyrazine, imidazole, etc? Those groups and more are embraced.

2. The term "heterocyclic group" and "carbocyclic group" are indefinite as to the number of carbon atoms. Are mono-cyclic, bicyclic, tricyclic, etc. intended?

3. The term "substituted" is non-limiting as to the number of substituents intended.

4. Claims 6 and 15 are unclear as to what is intended by [N-R<sup>8</sup>-N(R<sup>8</sup>R<sup>9</sup>-amino) C<sub>1-4</sub>alkyl]; and [N-C<sub>1-4</sub>alkyl-N(R<sup>8</sup>R<sup>9</sup>-amino) C<sub>1-4</sub> alkyl], respectively.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-17 are rejected under 35 U.S.C. 103 as being unpatentable over Miyasaka et al '256.

Art Unit 122

Miyasaka et al '256 describes compounds structurally similar to the instantly claimed compounds. The reference teaches substitution at the 10-position by an acyloxy moiety derived from aromatic carboxylic acids, heterocyclic carboxylic acids, alkyl, and aromatic sulfonic acids, etc. page 7.

The instantly claimed compounds would be obvious in view of the teaching of Miyasaka et al '256.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Miyasaka et al '692, '282' '276, '770, '642, Japan Patent '583, Sugawara '098 and Winterfeldt et al '029, Japan Patents '289 and '584.

Applicants are requested to provide copies of the prior art cited in the specification.

Gibson:bjk

A/C 703

557-3920

5/2/85

  
ROBERT GERSTL  
PRIMARY EXAMINER  
ART UNIT 122